

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Fisher et al

Appl. No.: 09/619,643

Filed: July 19, 2000

For: **Nucleic Acid Molecules and Other
Molecules Associated With Plants**

Art Unit: 1655

Examiner: J. Goldberg

Atty. Docket: 38-21(51230)B

FAX RECEIVED
APR 27 2001
GROUP 1600

Response to Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Madam:

In the Office Action mailed January 26, 2001, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: claim 1 drawn to a nucleic acid molecule classified in class 536, subclass 23.6;

Group II: claim 2, drawn to a maize protein, classified in class 530, subclass 376;

Group III: claims 3- 7, drawn to a transformed plant classified in class 800, subclass 295.

Applicants respectfully traverse the restriction requirement, and provisionally elect the claim of Group I (claim 1) for further prosecution.

Applicants submit that the complete examination of the application would be most expeditiously handled by treating all of the pending claims as a single entity. As Section 803 of the MPEP states, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." It is respectfully submitted that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. No serious burden is created, for example, when a simultaneous computerized search for the nucleic acids of Group I and the proteins of Group II is run. A single search may be run, for example, in conjunction with databases such as those available at <http://www.ncbi.nlm.nih>. In reality, a serious burden would arise if the application were restricted since the same references often describe both nucleic acid and protein.

Certificate of Facsimile Transmission

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, Fax No: 703-305-3014 on April 26, 2001


Linda T. Parker, Registration No. 46,046

Fisher *et al.*
Appl. No. 09/619,643

Based on the foregoing, Applicants submit that the restriction requirement is improper and therefore must be withdrawn. To facilitate prosecution, however, Applicants have provisionally elected, with traverse, Group I (claim 1).

The Office Action further requires that, in the event that Group I is elected, no more than 5 specific sequences may be specified for examination. In view of Applicants' provisional election of Group I, and in the event that the restriction requirement is made final, it is hereby requested that the following 5 sequences be examined in this application:

SEQ ID NO: 1;

SEQ ID NO: 2;

SEQ ID NO: 3;

SEQ ID NO: 4;

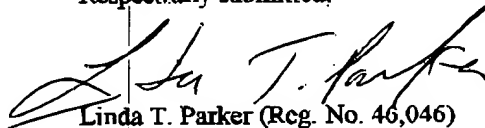
SEQ ID NO: 5;

However, the election of the above sequences is made with traverse. The Examiner's restriction to 5 sequences is improper. Examination of sequences for 4013 maize ESTs, all from leaf tissue, would not present an undue burden due to the interrelationship between the disclosed sequences.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicant's undersigned representative at (908) 684-8061.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 13-4125.

Respectfully submitted,



Linda T. Parker (Reg. No. 46,046)

Date: April 26, 2001

Patent Department, E2NA Monsanto Company
800 Lindbergh Blvd.
St. Louis, MO 63167
Tel: 314-694-3602
FAX: 314-737-7093

Certificate of Facsimile Transmission

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, Fax No: 703-305-3014 on April 26, 2001



Linda T. Parker, Registration No. 46,046